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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/265,779	03/10/1999	HEINRICH GERS-BARLAG	BEIERSDORF41	4916

7590

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EXAMINER

OWENS JR, HOWARD V

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 07/15/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/265,779

Applicant(s)

GER-S-BARLAG ET AL.

Examiner

Howard V Owens

Art Unit

1623

-- The MAILING DATE f this communication appears on the c ver sheet with the correspondence address --

## Peri d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002 .
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

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### DETAILED ACTION

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

#### Specification

A statement reading "This is a (Division, Continuation or Continuation in Part) of application Serial No. , filed , now U.S. Patent No. " should be entered following the title of the invention or as the first sentence of the specification.

#### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-13 of U.S. Patent No. 5,968,483 ('483). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant composition/method claims merely recite a species of the emulsifier genus set forth in the cosmetic or dermatological claims and the corresponding method of protecting the skin from UV light damage of '483. The selection of a specific emulsifier within the genus claimed in the parent would have been obvious to the person of ordinary skill in the art at the time of the invention for the purpose of obtaining a sunscreen product that would solubilize high levels of the light protective agent.

#### **Claim Rejections - USC 103 Rejection**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Hei-04/178316 in view of applicant's own admission on page 2, last paragraph, and page 4, last paragraph.

The claims are directed to a cosmetic or dermatological composition comprising a light protective amount of 4,4',4''-(1,3,5-triazine-2,4,6-tryltriimino)- trisbenzoic acid tris (2-ethylhexyl ester) and the emulsifier polyglyceryl 2-polyhydroxystearate. Claim 9 requires that there be at least one additional UVA or UVB filter. Claim 10 requires that there be at least one cosmetically or dermatologically acceptable inorganic pigment. Claim 11 requires the inclusion of at least one cosmetically or dermatologically acceptable auxiliary. Claim 12 requires the presence of at least one antioxidant. Claim 8 is directed to a method for protecting skin from UV light.

The Japanese laid-open specification JP Hei-04/178316 teaches that a genus of the emulsifiers that includes polyglyceryl 2-polyhydroxystearate are cosmetically and dermatologically compatible compounds. This Japanese specification does not disclose either the UV light screening compound nor the specific emulsifier of the instantly claimed compositions. However, the applicant acknowledges that the compound applicant employs as a sunscreen is known in the art as a sunscreen (page 2, last paragraph) and that it is commercially available from BASF Aktiengesellschaft. Additionally, the applicant acknowledges that the emulsifier (polyglyceryl 2-polyhydroxystearate) specified in the claims is also a commercially available product (page 4, last paragraph). Therefore, a cosmetic or dermatological composition comprising a known UV light screening agent known in the art and commercially available and an emulsifier also commercially available and taught as cosmetically and dermatologically safe and effective, would have been obvious to the person of ordinary skill in the art wanting an effective sunscreen composition with a high level of UV blocking agent maintained in appropriately in suspension in said composition by an art recognized emulsifier. The motivation to select the instant emulsifier is that it has

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already been used successfully in previous cosmetic and/or dermatological compositions as taught by JP '316. It would also have been *prima facie* obvious to have added one or more additional UVA or UVB compounds or standard cosmetic pigment, standard antioxidants, or standard auxiliaries to said sunscreen to obtain the art recognized benefits therefrom. One of skill in the art would have been motivated to use the above composition to protect skin from UV light damage would also have been obvious because the active ingredient itself is a sun screening compound.

Applicant's arguments filed 10/21/02 have been fully considered but they are not persuasive.

Applicant's primary response is that rejection of claims in the parent application were not similarly rejected with the prior art of record and the admission in the specification; therefore, as a matter of law the current claims should not be rejected; however, applicant does not argue the actual merits of the combination of the prior art and the admission that forms the basis of the obviousness rejection; moreover, there is nothing unusual, certainly, about an Examiner changing his viewpoint as the prosecution of a case progresses, and, so long as the rules of the Patent Office Practice are duly complied with, an applicant has no legal complaint because of such change in view. *In re Ellis*, 31 USPQ 380; *In re Becker*, 40 USPQ 624. As such the rejection of record is maintained. Note, if applicant maintains the position that that the rejection of record is equally applicable to the parent application, 08/788,147, now U.S. Patent 5,968,483 ('483), a reexamination of '483 may be warranted.

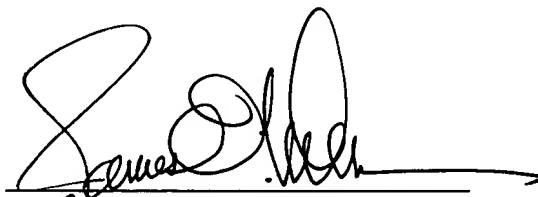
All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Howard V. Owens  
Patent Examiner  
Art Unit 1623



James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.